

## II. Double Patenting Rejection

The Examiner has maintained the rejection of claims 38-58, 60, 69, 78, 79, 83, 84, and 88-106 under the judicially created doctrine of obviousness-type double patenting over claims 1-41 of U.S. Patent No. 6,346,234 to Rollat et al. (“the ’234 patent”), in view of EP 0 551 749 to Lee et al. (“*Lee*”) for the reasons of record. Office Action, pages 2-3. In addition, the Examiner alleges that, for a double patenting rejection, it is proper to rely on the claims of the primary reference, *i.e.*, the ’234 patent, and on the disclosure of the secondary reference, *i.e.*, *Lee*, because *Lee* “is cited to show the level of the art, and therefore is not limited to the claims therein.” *Id.* at pages 2-3; *see also id.*, at page 6. Applicants respectfully traverse this rejection for the reasons of record and the following reasons.

Even, solely for the purpose of argument, if the Examiner may rely on *Lee*’s disclosure to “show the level of the art,” the Examiner has failed to point to any evidence of a suggestion or motivation to modify the composition claimed in the ’234 patent by adding into it the water-soluble amphoteric polymer disclosed in *Lee*. Specifically, the Examiner alleged that because the “water soluble amphoteric polymer provides a very substantial hold, and [aids] in removing the water-insoluble resin in a hair composition from the hair upon shampooing” (citing *Lee*, page 3, lines 5-14), it would have been obvious to add the water-soluble amphoteric polymer into the composition claimed in the ’234 patent. Applicants respectfully disagree because *Lee* clearly teaches that the superior hairspray properties disclosed therein are the result of the interaction between the water-insoluble, dispersible polymeric resin having a specific viscosity and a water-

soluble amphoteric polymer. *See Lee*, page 3, lines 6-9. Therefore, contrary to the Examiner's allegation, the superior hairspray properties disclosed in *Lee* are not known in the art as the property for the water-soluble amphoteric polymer. One of ordinary skill in the art would not have been motivated to pick the water-soluble amphoteric polymer alone and add it into the composition claimed in the '234 patent.

Accordingly, this rejection is improper. Applicants respectfully request this rejection be withdrawn.

### **III. Rejection Under 35 U.S.C. § 112, First Paragraph**

The Examiner has also maintained the rejection of claims 38-43, 45-50, 69, 78, 79, 83, 84, and 88-106 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement because the "claims are directed to compositions comprising polymers which are solely defined by physical properties." Office Action, page 4. Further, the Examiner states "the general description of tacky polymer is purely functional, lacking any information coupling the functional properties to the chemical structure of the tacky polymer." *Id.* at page 7. In addition, the Examiner alleges that "Applicants provide no way for identifying a tacky polymer other than test[ing] and see[ing], suggesting the tacky properties required herein [are] unpredictable." *Id.* Applicants respectfully disagree with the Examiner for the reasons of record and the following additional reasons.

Contrary to the Examiner's allegation, and, indeed, as the Examiner admits, "tacky" is a physical property (see Office Action, page 3) rather than a functional

limitation. The quotations cited by the Examiner in the Office Action, on page 6, are not applicable for physical-property limitations, but solely for functional limitations.

Further, “[a]n adequate written description of the invention may be shown by any description of sufficient, relevant, identifying characteristics so long as a person skilled in the art would recognize that the inventor had possession of the claimed invention.” M.P.E.P. § 2163 II.3.(a) (emphasis added). The present specification provides embodiments of the “tacky polymer” as presently claimed, such as branched sulphonic polymers or (meth)acrylic ester polymers on page 6, lines 21-23, guidance on how to form the branched sulphonic polyester and the (meth)acrylic ester and specific examples thereof on page 7, lines 5 - page 12, line 16. The present specification on pages 4-6 also provides guidance on how to determine the maximum peeling force  $F_{\max}$  and the energy for separation  $E_{s(M/V)}$ , which are physical properties of the “tacky polymer” as presently claimed. Therefore, one of ordinary skill in the art would recognize that the inventors had possession of the claimed invention at the time of filing. Testing and using the tacky properties as the relevant, identifying characteristics is permissible and does not violate the written description requirement.

Accordingly, this rejection is improper. Applicants respectfully request this rejection be withdrawn.

#### **IV. Rejection Under 35 U.S.C. § 103 (a)**

The Examiner has also maintained the rejection of claims 38-58, 60, 69, 78, 79, 83, 84, and 88-106 under 35 U.S.C. §103 over *Lee* in view of WO 95/18191 to Miller et al. (“*Miller*”) for the reasons of record. Office Action, pages 4-5. In addition, the

Examiner alleges that because *Miller* in particular “teaches the polymer with lower Tg hav[ing] many advantage[s] over higher Tg polymer,” it “is reasonably pertinent to the particular problem with which the applicants were concern[ed].” *Id.* at page 7.

Therefore, the Examiner concludes that *Miller* is analogous art, and can be used as a reference for the Section 103(a) rejection. *Id.* Applicants respectfully disagree and traverse this rejection for the reasons of record and the following additional reason.

First, contrary to the Examiner’s allegation, *Miller* does not teach “the polymer with lower Tg hav[ing] many advantage[s] over higher Tg polymer.” Instead, *Miller* teaches that its adhesive composition with a lower Tg “will not be brittle, thus cartons adhered together with the adhesive compositions of the present invention when impacted, even at extremely cold temperatures will not shatter and thus maintain adhesion.” *Miller*, page 18, lines 10-15.

Second, contrary to the Examiner’s allegation, *Miller* is not reasonably pertinent to the problems with which Applicants were concerned. Here, Applicants were searching, for example, for a hairstyling composition that offers “a sufficiently strong fixing and maintaining effect for the hairstyle to suitably withstand the various stresses over time” and “good cosmetic properties, in particular in terms of disentanglement, softness and feel.” Specification, page 3, lines 8-19. In contrast, *Miller*’s invention is directed to “a water-dissipatable or dispersible adhesive composition that is useful in forming paper articles and other products that can be recycled through repulping in both neutral and alkaline media.” *Miller*, abstract; *see also id.* at pages 1-3. It is not seen how an adhesive that forms recyclable paper product is reasonably pertinent to the

problems associated with, for example, hairstyling compositions as investigated by the Applicants.

Therefore, *Miller* is not an analogous art. Accordingly, this rejection is improper. Applicants respectfully request this rejection be withdrawn.

## V. Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, he is invited to call the undersigned Applicants' representative at (202) 408-4218.

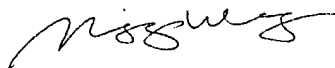
If there is any fee due in connection with the filing of this response, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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By:



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